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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,776	11/19/2003	Arlan James Reschke	2936	6165

50855 7590 07/20/2006

UNITED STATES SURGICAL,  
A DIVISION OF TYCO HEALTHCARE GROUP LP  
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EXAMINER

TOY, ALEX B

ART UNIT PAPER NUMBER

3739

DATE MAILED: 07/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/716,776	RESCHKE, ARLAN JAMES	
	Examiner	Art Unit	
	Alex B. Toy	3739	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 7-13, 15-20, 22-26 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 14, 21 and 27-31 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/22/04; 4/15/05</u> | 6) <input checked="" type="checkbox"/> Other: <u>IDS: 4/10/06; 5/22/06; 7/3/06</u>      |

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 7-13, 15-20, 22-26, and 32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on June 26, 2006.

### ***Claim Objections***

Claim 14 is objected to because of the following informalities: "the resilient handle" lacks antecedent basis in claim 1. For the purposes of examination, it is assumed that applicant intended claim 14 to depend from claim 2. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 21, 27-28, and 30-31 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wood (U.S. PGPub 2002/0151886 A1).

Regarding claim 1, Wood discloses an electrosurgical pencil, comprising:

- a housing 20, 61 (Figs. 1 and 3A);
- an electrode 62 supported within the housing and extending distally from the housing 61 (Fig. 3A), the electrode being connected to a source of electrosurgical energy (pg. 6, ¶ 64);
- an activation button configured and adapted to selectively supply electrosurgical energy to the electrode upon actuation thereof (pg. 3-4, ¶ 35 and 44); and
- an aspirating/irrigating system operatively connected to the housing, wherein the aspirating/irrigating system is configured and adapted to manually perform at least one of delivering a quantity of fluid to a target surgical site and withdrawing a quantity of fluid from the target surgical site (pg. 4, ¶ 42, pg. 6, ¶ 64, and Figs. 1 and 3A).

Since the power delivered to the electrode is controlled by a microprocessor, the device of Wood obviously, if not inherently, comprises an activation button as claimed, even if the button merely comprises a button to turn on and activate the microprocessor.

Regarding claim 2, Wood discloses the electrosurgical pencil according to claim 1, wherein the aspirating/irrigating system includes a resilient handle 25, the resilient handle defining at least one chamber therein.

Since the plunger and tube portion of the syringe are both designed to be held and operated by hand, the entire syringe comprises a handle. In addition, applicant has not specifically defined "handle". Therefore, the broadest reasonable interpretation of handle is used. The chamber is formed by the insertion of the plunger into the tube. Finally, it is well-known in the art that syringes are commonly made of plastic which is

inherently resilient. Therefore, the syringe of Wood is obviously, if not inherently, resilient.

Regarding claim 3, Wood discloses the electrosurgical pencil according to claims 1 and 2, wherein the aspirating/irrigating system further includes a fluid passage (the inner lumen 66 of electrode 62) extending between the at least one chamber of the resilient handle and at least one aperture (the distal opening) formed in a distal end of the housing 61 (pg. 6, ¶ 64).

Regarding claim 4, Wood discloses the electrosurgical pencil according to claims 1-3, wherein a quantity of fluid is contained within the at least one chamber of the resilient handle (pg. 6, ¶ 64).

Regarding claim 5, Wood discloses the electrosurgical pencil according to claims 1-4, wherein the resilient handle has an expanded condition and is compressible to a non-expanded condition, wherein compression of the resilient handle causes the quantity of fluid contained in the at least one chamber of the resilient handle to be urged through the fluid passage and out of the at least one aperture formed in the distal end of the housing (pg. 6, ¶ 64).

The expanded condition is when the syringe plunger is extended, and the non-expanded condition is when the plunger is compressed into the syringe tube.

Regarding claim 6, Wood discloses the electrosurgical pencil according to claims 1-5, wherein when the resilient handle is allowed to return to its expanded condition from the non-expanded condition, fluid is drawn into the at least one chamber of the

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resilient handle through the fluid passage and in through the at least one aperture formed in the distal end of the housing.

The device of Wood is inherently capable of performing the intended use of drawing in fluid as claimed.

Regarding claim 21, see the preceding rejections of claims 1-5.

Regarding claim 27, see the preceding rejections of claims 1-5.

Regarding claim 28, see the preceding rejections of claims 3 and 27.

Regarding claims 30-31, see the preceding rejections of claims 1-3.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wood (U.S. PGPub 2002/0151886 A1) in view of Spitz (U.S. Pat. No. 6,352,544 B1).

Regarding claim 14, Wood discloses the electrosurgical pencil according to claims 1 and 2. The claim differs from Wood in calling for the resilient handle to be fabricated from rubber. Spitz, however, teaches using a rubber bulb or a syringe as obvious interchangeable means for injecting fluid into a catheter lumen (col. 5, ln. 56-59). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a rubber bulb instead of a syringe to inject fluid with the device of Wood in view of the teaching of Spitz that a rubber bulb and a syringe are obvious interchangeable means for injecting fluid into a catheter lumen. Thus, the resilient handle of Wood in view of Spitz is fabricated from rubber.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wood (U.S. PGPub 2002/0151886 A1) in view of Abele (U.S. Pat. No. 5,190,541)

Regarding claim 29, Wood discloses the method of claims 27 and 28. The claim differs from Wood in calling for the step of:

partially compressing the handle and placing the aperture in a quantity of fluid and allowing the handle to expand to withdraw fluid into the at least one chamber.

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Abele, however, discloses an analogous electrosurgical device with a separate suction syringe 26 in addition to a fluid delivery syringe 28, wherein the step as claimed is performed to clean and remove blood from the surgical area (col. 7, ln. 14-25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided an additional suction syringe and performed the step as claimed with the device of Wood in view of the teaching of Abele in order to clean and remove blood from the surgical area.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US 2102270 A	USOCR	HYAMS MORTIMER N
US 3494363 A	USOCR	JACKSON RICHARD
US 4620548 A	USPAT	Hasselbrack; Robert
US 4796623 A	USPAT	Krasner; Gary N. et al.
US 5254117 A	USPAT	Rigby; Larry et al.
US 5322503 A	USPAT	Desai; Ashvin H.
US 5599346 A	USPAT	Edwards; Stuart D. et al.
US 5634935 A	USPAT	Taheri; Syde A.
US 5879347 A	USPAT	Saadat; Vahid
US 6068603 A	USPAT	Suzuki; Takayuki
US 20020026145 A1	US-PGPUB	Bagaoisan, Celso J. et al.
US 20020103485 A1	US-PGPUB	Melnyk, Ivan et al.
US 20020133148 A1	US-PGPUB	Daniel, Steven A. et al.
US 6526320 B2	USPAT	Mitchell; James
US 20030055421 A1	US-PGPUB	West, Scott H. et al.

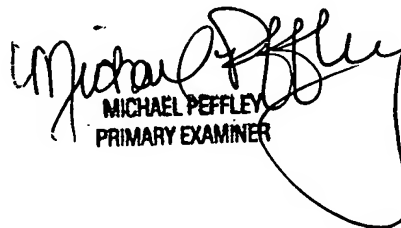
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex B. Toy whose telephone number is (571) 272-1953. The examiner can normally be reached on Monday through Friday, 8:00 AM to 4:30 PM.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AT AT  
7/7/06

  
MICHAEL PEFFLEY  
PRIMARY EXAMINER